

REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

As correctly noted in the Office Action Summary, claims 6-10 and 12 were pending. By the present response, claims 6, 9 and 10 have been amended and claims 13-37 have been added. Thus, upon entry of the present response, claims 6-10 and 12-37 remain pending and await further consideration on the merits.

Support for the foregoing amendments can be found, for example, in at least the following locations in the original disclosure: the original claims and the specification, paragraph [0013], [0014], [0019], [0021], [0024] and [0025].

ALLOWABLE SUBJECT MATTER

Applicants note with appreciation the indication of allowable subject matter in objected claim 10. By the present response, claim 10 has been rewritten in independent form including the features of any intervening claims. Further, new claims 13-26 have been added dependent from independent claim 10. Therefore, claims 10 and 13-26 are allowable for at least the reasons noted in the Official Action with regards to original claim 10.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 6-9 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,261,639 to Shibata et al. (hereafter "*Shibata et al.*") on the grounds set forth in paragraph 2 of the Official Action. Claims 6, 7, 9 and 12 stand

rejected under 35 U.S.C. §102(b) as being anticipated by JP 60-218429 (hereafter "*JP '429*"), with U.S. Patent No. 4,709,742 to Harase et al. (hereafter "*Harase et al.*") on the grounds set forth in paragraph 3 of the Official Action. For at least the reasons noted below, this rejection should be withdrawn.

To anticipate a claim, the reference must teach every element of the claim. See MPEP § 2131. For example, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). Here, the rejections are traversed because each of the cited references does not teach every element of the claim. The following comments on each of the references are offered.

Shibata et al. discloses surface treating a stainless steel with a mixture containing at least one of a Ca compound and a Ba compound and a binder. Table 1 lists the disclosed stainless steels (Nos. 1-10) and Table 2 lists the disclosed surface treatment compositions (Nos. 1-26). Of the listed stainless steels, all of the steels have an Al content below the claimed at least 1.5 wt.%. (claim 6) except for No. 8. However, only three of the surface treatment compositions are disclosed in combination with steel No. 8, e.g., surface treatment compositions Nos. 1, 18 and 26 (see, e.g., Table 3 and Table 4). These three surface treatment compositions do not have a Ca-content within the claimed range of 0.05 wt.% to 10 wt.% Ca.

Comparing the disclosure in *Shibata et al.* to the claims of the present application at issue here, the *Shibata et al.* patent does not disclose the claimed FeCrAl-alloy and the claimed composition of the Ca-containing layer. In light of at

least these differences, Applicants respectfully submit that an anticipatory rejection is improper since *Shibata et al.* does not disclose the invention as claimed.

JP '429 discloses treating a stainless steel strip (SUS 430) with NaOH or Ca(OH)_2 aq. soln. The examiner references *Harase et al.* to show that SUS 430 has a composition of 0.05 wt.% C, 17 wt.% Cr, 0.12 wt.% Al, 0.01 wt.% N and balance Fe (see Table 2 of *Harase et al.*). Comparing the disclosure in *JP '429* to the claims of the present application at issue here, the *JP '429* patent does not disclose at least the claimed FeCrAl-alloy. Further, the *JP '429* patent does not disclose at least the claimed composition of the Ca-containing layer. Rather, the *JP '429* patent discloses an alloy with 0.12 wt.% Al and an unspecified composition of the Ca-containing layer beyond "NaOH or Ca(OH)_2 aq. soln." In light of at least these differences, Applicants respectfully submit that an anticipatory rejection is improper since *JP '429* does not disclose the invention as claimed.

For at least the reasons noted above, withdrawal of the rejections is respectfully requested. Further, since the dependent claims contain all of the features of the independent claim, they also distinguish over the cited references for at least the same reasons as noted above and withdrawal of the rejections with respect to these claims is also respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Shibata et al.* on the grounds set forth in paragraph 5 of the Official Action. Claim 12 depends from claim 6 and distinguishes over the *Shibata et al.* reference for at least

the same reasons as noted above with respect to claim 6. Therefore, withdrawal of the rejections with respect to this claim is respectfully requested.

CONCLUSION

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

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